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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/221,931	12/28/1998	TAKASHI TSURUO	WAKAB37.001A	3902

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EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 11/15/2001

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/221,931

Applicant(s)
Tsuruo et al

Examiner
Michael Borin

Art Unit
1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Oct 5, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Oct 5, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).

6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
SEE ATTACHED

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: _____


Claim(s) objected to: _____

Claim(s) rejected: 11 and 17-21

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.

10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

11. ☐ Other:


MICHAEL BORIN
PRIMARY EXAMINER
ART UNIT 1631

Art Unit: 1631

DETAILED ACTION

In regard to rejection of claims 11, 17-21 under 35 U.S.C. 112, first paragraph, applicants argue that Examples 4,5 demonstrate effect of 15 μ M EGCG. However, use of 15 μ M is in no way a demonstration of the existence of the lower limit of concentration of catechins, set at 10 μ M, as now claimed. Further, applicant, again, points at Fig.2. There is no lower limit of concentration of catechins, set at 10 μ M, on Figure 2. If anything, Figure 2 demonstrates that the inhibition can be achieved at far lower concentrations than it is now claimed.

In regard to the rejection of claims 11, 17-20 under 35 U.S.C. 102(b) as anticipated by JP 910108977 (the reference is used to meet the dosage range limitation, even though this limitation is a subject to the rejection under 35 U.S.C. 112, first paragraph, discussed above), applicant argues that the reference teaches a mixture of six catechins. First, the six catechins mentioned in the reference are given as exemplary components of polyphenols of the composition. Even if all components had to be present together, the claims are drawn to use of composition comprising a catechin, and the instant specification guides that, in the same manner as the referenced composition, catechins can be used merely as a crude green tea extract, or as "one or more catechins". See page 5, first full paragraph. As for applicant's recalculation of 10 μ M of EGCG into percentile concentration, applicants argument that such concentration is not taught in the reference is not well taken because the claims are not drawn to a single particular concentration. Rather, the claims are

Art Unit: 1631

drawn to any composition comprising a catechin at a concentration of at least 10 μ M, i.e. the concentration range has no upper limit. Consequently, as the reference indicates a concentration of above 10 μ M, it reads on the claimed concentration range.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

November 7, 2001

mlb